

## **REMARKS**

### **Objection to Declaration**

A substitute Declaration which addresses the Examiner's objection to the originally filed Declaration accompanies this response.

### **Amendments to the Specification**

The paragraphs numbered [0009] - [0043] have been replaced by paragraphs [0009] – [0043.1] to conform the Summary with the current version of the claims. The Applicants submit that no new subject matter is added by this amendment.

The paragraph numbered [0048] has been amended to include additional detail of the nature of an update package or update information. The support for the additional text may be found in the PCT application with International Publication Number WO 02/4117 A1, filed November 19, 2001 as PCT Application PCT/US01/44034, the complete subject matter of which was incorporated by reference in the Application at the time of filing. (e.g., see at least, p. 5, ll. 24-25; p. 11, ll. 8-11; p.11, ll. 25-27) The Applicants submit that no new subject matter is added by this amendment.

### **Amendments to the Claims**

Claim 1 has been amended to include additional text defining the update information, and to use the term “a first code version” and “a second code version” in place of “at least one of firmware and software”. The support for the additional text may be found in amended paragraph [0048]. The term “code” is defined as “program instructions.” (see e.g., Microsoft Press Computer Dictionary Third Edition, 1997, pg. 96) The Applicants submit that no new subject matter is added by this amendment.

Claims 6, 9-16, and 18 have been amended to correct antecedent basis issues. The Applicants submit that no new subject matter is added by this amendment.

Claim 7 has been amended to correct a minor typographical error. The Applicants submit that no new subject matter is added by this amendment.

Claim 19 has been amended to direct the claim to “machine-readable storage” rather than “system”, to include additional text defining the update information, and to use the term “code” in place of “at least one of firmware and software”. The support for the additional text regarding update information may be found in amended paragraph [0048]. The term “code” is defined as “program instructions.” (see e.g., Microsoft Press Computer Dictionary Third Edition, 1997, pg. 96) The Applicants submit that no new subject matter is added by this amendment.

Claim 20 has been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19, and to conform the claim with Fig. 1 of the Application. The Applicants submit that no new subject matter is added by this amendment.

Claims 21-22, 25, 33-34 have been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19. The Applicants submit that no new subject matter is added by this amendment.

Claims 23 and 26-31 have been amended to use the term “machine-readable storage” in place of “system”, to be consistent with independent claim 19, and to correct antecedent basis issues. The Applicants submit that no new subject matter is added by this amendment.

Claim 24 has been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19, and to correct a minor typographical error. The Applicants submit that no new subject matter is added by this amendment.

Claim 27 has been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19, to correct antecedent basis issues, and to correct a minor typographical error.

Claim 32 has been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19, to conform the claim to Fig. 1 of the

Application, and to correct a minor typographical error. The Applicants submit that no new subject matter is added by this amendment.

Claim 35 has been amended to use the term “machine-readable storage” in place of “system” to be consistent with independent claim 19, and to more clearly define the claimed subject matter.

Claims 36 and 37 have been added.

### **Rejections of Claims**

Claims 1-35 are pending in the application. Claims 1 and 19 are independent claims. Claims 2-18 and 20-35 depend either directly or indirectly from independent claims 1 and 19, respectively. New claims 36-37 have been added. The Applicants request reconsideration of the pending claims 1-35, and new claims 36-37, in light of the following remarks.

Claims 10-12, 14-15, 27, 30, and 32 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicants respectfully traverse the rejection. However, in the interest of advancing the Application to allowance, the Applicants have amended claims 10-12, 14-15, 27, 30, and 32. The Applicants believe that claims 10-12, 14-15, 27, 30, and 32 meet the requirements of 35 U.S.C. §112, second paragraph, and submit that claim 10-12, 14-15, 27, 30, and 32 are in a condition for allowance. The Applicants therefore request that the rejection of claims 10-12, 14, 15, 27, 30, and 32 under 35 U.S.C. §112 be withdrawn.

Claims 19, 23-24, 25, 31, and 34-35 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Applicants respectfully traverse the rejection. However, in the interest of advancing the Application to allowance, the Applicants have amended claims 19, 23-24, 25, 31, and 34-35. The Applicants believe that amended claims 19, 23-24, 25, 31, and 34-35 meet the requirements of 35 U.S.C. §101, second paragraph, and submit that claims 19, 23-24, 25, 31, and 34-35 are in a condition for allowance. The Applicants therefore request that the rejection of claims 19, 23-24, 25, 31, and 34-35 under 35 U.S.C. §101 be withdrawn.

Claims 1-10, 19-27, and 35 were rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application No. 2001/0008024 A1 by Inaba. The Applicants respectfully traverse the rejection. Regarding amended claim 1, the Applicants submit that the Inaba reference does not teach, suggest, or disclose, for example, a method for updating an electronic device, the method comprising updating a first code version in the electronic device to a second code version using update information comprising a set of instructions for converting the first code version to the second code version, and converting data associated with the first code version to a form compatible with the second code version.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Inaba is different from and fails to anticipate the Applicants' invention as set forth in claim 1, as amended. Because claims 2-18 and 36 depend either directly or indirectly upon claim 1, Inaba is different from and fails to anticipate claims 2-18 and 36, as well. Therefore, the Applicants believe that claims 1-18 and 36 are allowable over the Inaba reference. The Applicants respectfully request that the rejection of claims 1-10 under 35 U.S.C. §102(a), be withdrawn.

Regarding claim 19, the Applicants submit that the Inaba reference does not teach, suggest, or disclose, for example, a machine-readable storage, having stored thereon a computer program having a plurality of code sections executable by a machine for causing the machine to perform operations for updating an electronic device, the machine-readable storage comprising code comprising an update agent, for coordinating updating of code in the electronic device using update information comprising a set of instructions for converting the code to an updated code, and code comprising a converter, for invoking a converter utility associated with the code and for converting data associated with the code to a form compatible with an updated version of the code.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Inaba is different from and fails to anticipate the Applicants' invention as set forth in claim 19, as amended. Because claims 20-35 and 37 depend either directly or indirectly upon claim 19, Inaba is different from and fails to anticipate claims 20-35 and 37, as well. Therefore, the Applicants believe that claims 19-35 and 37 are allowable over the Inaba reference. The Applicants

respectfully request that the rejection of claims 19-27 and 35 under 35 U.S.C. §102(a), be withdrawn.

Claims 11-18 and 29-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2001/0008024 A1 by Inaba, as applied to claims 1-10 and 19-27, in view of U.S. Patent No. 6,587,684 to Hsu et al (“Hsu”). The Applicants respectfully traverse the rejection. Regarding claims 11-18, claims 11-18 depend directly or indirectly upon amended independent claim 1. Because amended claim 1 is allowable, the Applicants respectfully submit that claims 11-18 are allowable over the proposed combination of references. Therefore, the Applicants respectfully request that the rejection of claims 11-18 under 35 U.S.C. §103(a), be withdrawn.

Regarding claims 29-34, claims 29-34 depend directly or indirectly upon amended independent claim 19. Because amended claim 19 is allowable, the Applicants respectfully submit that claims 29-34 are allowable over the proposed combination of references. Therefore, the Applicants respectfully request that the rejection of claims 29-34 under 35 U.S.C. §103(a), be withdrawn.

A new claim 36 that depends from independent claim 1 has been added. Support for dependent claim 36 may at least be found, for example, in paragraphs [0048], [0049], and [0050]. The Applicants respectfully submit that the addition of claim 36 does not add new matter. Because independent claim 1 is allowable, Applicants assert that the dependent claim 36 is also allowable.

A new claim 37 that depends from independent claim 19 has been added. Support for dependent claim 37 may at least be found, for example, in paragraphs [0048], [0049], and [0050]. The Applicants respectfully submit that the addition of claim 37 does not add new matter.

Because independent claim 19 is allowable, Applicants assert that the dependent claim 37 is also allowable.

## Conclusion

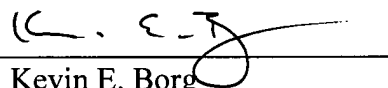
The Applicants believe that all of claims 1-37 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

Dated: March 9, 2005

  
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